

REMARKS

Claims 1-11 are pending in the application. By this Amendment, claims 10 and 11 are amended to clarify the disclosed embodiments. No new matter is added by these amendments, and these amendments are supported fully by the specification. Applicants respectfully request that the Examiner enter the foregoing amendments and reconsider the patent application in view of the foregoing amendments and the following remarks.

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,642,247 to Mouri et al. in view of U.S. Patent No. 6,419,356 to Sadasivan et al. The rejection is respectfully traversed.

In order to establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the combined references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be some expectation of success. Third, the cited references must disclose or suggest all of the claim limitations. MPEP 2143. Applicants maintain that the Office Action fails to establish a prima facie case of obviousness with respect to claims 1-11.

Mouri describes a recording medium having an upper layer and an under layer that is more hydrophilic than the upper layer. Sadasivan describes an ink-receiving layer containing a surfactant having an HLB number of less than about 10.

The references, alone or in combination, do not disclose or suggest all of the claimed limitations. Claim 1 discloses "the ink-permeable layer comprising a surfactant having an HLB value of 9 or less." Neither Mouri nor Sadasivan discloses or suggests the ink-permeable layer having an HLB value of 9 or less. Sadasivan describes HLB values as applied to the ink-receiving layer, not the ink-permeable layer. Thus, all of the claimed limitations are not disclosed or suggested by the cited references.

Further, the Office Action does not provide evidence of a motivation to combine Mouri and Sadavisan. Sadavisan does not discuss an upper layer, or ink-permeable layer, that is less hydrophilic than an under layer. The surfactant of Sadavisan correlates to the ink-receiving layer. Thus, Mouri and Sadavisan fail to provide the requisite suggestion for combining and/or modifying their teachings to arrive at the claimed invention. Applicants maintain that the Office Action does not provide any evidence of a motivation to add a surfactant to the upper layer of Mouri having an HLB of 9 or less. Thus, Applicants maintain that claims 1-11 are not rendered obvious by the cited references. Therefore, withdrawal of the rejection of claims 1-11 under 35 U.S.C. § 103 is respectfully requested.

CONCLUSION

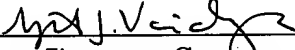
In view of the foregoing, Applicants respectfully request the reconsideration and the timely allowance of the pending claims. Should the Examiner feel that

there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1349. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

10. (Amended) The recording sheet according to claim 4, wherein the ink-receiving layer further comprises a hydrophilic fixing aid comprising a resin different from the [fixing agent] cation group-containing compound.

11. (Amended) The recording sheet according to claim 7, wherein the ink-receiving layer further comprises a hydrophilic fixing aid comprising a resin different from the [fixing agent] cation group-containing compound.